

REMARKS

I. Introduction

In a non-final Office Action mailed on May 22, 2008, the Examiner: (1) rejected claims 1, 18, 22, and 26 under 35 U.S.C. § 101; (2) rejected claims 1, 18, and 22 under 35 U.S.C. § 112, second paragraph; (3) rejected claims 1-7, 11, 14, 16-18, 20-23, 26-27, 29-32, 34-40, 43-45, 49, 51-54, 57-59, and 61-67 under 35 U.S.C. § 103(a) over a combination of U.S. Patent No. 6,173,274 ("Ryan") and International Application No. WO96/29263 ("Giacomozzi"); (4) rejected claims 8-9, 24, 28, 42, and 56 under 35 U.S.C. § 103(a) over a combination of Ryan, Giacomozzi, and U.S. Patent No. 5,473,863 ("Itkonen"); (5) rejected claims 10, 25, 33, 41, 55, 60, and 64 under 35 U.S.C. § 103(a) over a combination of Ryan, Giacomozzi, and U.S. Patent No. 5,035,515 ("Crossman"); and (6) rejected claims 12-13, 15, 19, 46-47, and 50 under 35 U.S.C. § 103(a) over a combination of Ryan, Giacomozzi, and U.S. Patent No. 6,421,652 ("Loeb").

Claims 1-47 and 49-67 are pending. Applicant herein amends claims 1, 11, 18, 22, 26-30, and 61 to clarify the subject matter for which applicant seeks protection. For reasons discussed in detail below, applicant respectfully submits that the pending claims are in condition for allowance.

II. Rejections Under 35 U.S.C. § 101

A. Claim 26

The Examiner rejected claim 26 under 35 U.S.C. § 101. In particular, the Examiner suggests that claim 26 is directed to non-statutory subject matter for reciting "a computer readable medium without any executable software code." (Office Action, May 22, 2008, page 2.) Although applicant respectfully disagrees with this suggestion, applicant herein amends claim 26 to recite "[a] computer-readable storage medium comprising instructions that, when executed by a processor, cause the processor to

perform a method for tracking a transaction among a paper product manufacturer, a paper product purchaser, and a third-party advertiser." Accordingly, applicant respectfully requests that the Examiner reconsider and withdraw this rejection.

B. Claims 1, 18, and 22

The Examiner also rejected claims 1, 18, and 22 under 35 U.S.C. § 101. In particular, the Examiner suggests that these claims recite software *per se*. (Office Action, May 22, 2008, page 2.) Applicant respectfully disagrees. The claims are directed to a "computer system" that includes tracker components that perform the recited functions. The Federal Circuit some 14 years ago made it clear that "a general purpose computer in effect becomes a special purpose computer once it is programmed to perform particular functions pursuant to instructions from program software" and that "a computer operating pursuant to software *may* represent patentable subject matter, provided, of course, that the claimed subject matter meets all of the other requirements of Title 35." (*In re Alappat*, 31 U.S.P.Q.2d 1545, 1558 (Fed. Cir. 1994).) Claims 1, 18, and 22 are directed to a computer system operating pursuant to the software of the components. Moreover, the Federal Circuit further made it clear that hardware elements in a claim preamble cannot be ignored. (*Id.*) Thus, the Examiner cannot ignore the "computer system" language of the preamble and assert that the claims are directed to software *per se*.

Nevertheless, to advance examination, applicant has amended claims 1, 18, and 22 to recite a computer system that includes "a processor and a memory including instructions together providing" the recited trackers. As such, the amended claims are inarguably directed to statutory subject matter and are not software *per se*. Accordingly, applicant respectfully requests that the Examiner reconsider and withdraw this rejection.

III. Rejections Under 35 U.S.C. § 112

The Examiner rejected claims 1, 18, and 22 under 35 U.S.C. § 112, second paragraph. In particular, the Examiner suggests that the claims recite software and, therefore, lack the necessary structural elements. (Office Action, May 22, 2008, pages 2-3.) Although applicant respectfully disagrees, to advance examination applicant has nevertheless amended these claims to recite a computer system that includes "a processor and a memory together providing" the recited tracker components. Accordingly, applicant respectfully requests that the Examiner reconsider and withdraw this rejection.

IV. Rejections Under 35 U.S.C. § 103(a)

The Examiner rejected claims 1-47 and 49-67 under 35 U.S.C. § 103 over combinations of Ryan, Giacomozzi, Itkonen, Crossman, and Loeb. Applicant respectfully traverses these rejections and submits that none of the cited references, alone or in combination, teaches each of the elements recited by the pending claims.

A. Cited References

1. Ryan

Ryan describes a production mail system for printing messages, such as advertisements, on envelopes addressed to a single, specific recipient. During operation, the sender submits a mailing list to the data processing system for processing. (Ryan, 11:28-30.) The mailing list includes multiple recipient addresses to which the sender wishes to send mail pieces. (*Id.*, 11:30-32.) The data processing system reviews the mailing list and determines which recipients should have advertisements printed on their envelopes. (*Id.*, 11:41-46.) The data processing system also selects advertisements for each specific recipient based on the advertiser's restriction data, the recipient's address, and the demographic information in an address demographics database. (*Id.*, 11:61-67.) As a result, one or more specific

advertisements are printed on each envelope, and are sent to the single recipient of the envelope. (*Id.*, 12:28-29.)

2. Giacomozzi

Giacomozzi describes paper handkerchief wrappers that have advertisements printed on the outside of the wrappers. (Giacomozzi, page 1.) The advertisements are not linked to the handkerchiefs and Giacomozzi's method does not exercise any control over who will see each advertisement. In particular, the advertisements are not targeted to any specific person or group of people.

3. Itkonen

Itkonen describes a technique for evenly tightening a wrapper around a paper roll to produce a smooth and durable roll package. (Itkonen, 2:52-53, 3:4.) Itkonen mentions that "[r]oll wrappers are often printed with factory logos, thus acting as factory 'visiting cards'." (*Id.*, 1:64-67.) According to Itkonen, it is important to remove the crease in roll wrappers because, "[a] creased roll wrapper looks ugly and thereby acts as bad advertising for the product and factory image." (*Id.*)

4. Crossman

Crossman describes a package, such as a retail shopping bag, that has a detachable coupon compartment. (Crossman, 1:5-9, 4:10-13.) Crossman makes clear that "[w]hen the coupon compartment is detached, the packaging is still functional." Crossman discredits techniques that print promotional messages directly onto the packaging because "[c]oupons printed directly onto packaging...are not easily removed and if they are removed, the packaging is damaged." (*Id.*, 1:10:22.)

5. Loeb

Loeb describes a technique for providing a consumer with free subscriptions to trade publications based on the consumer's answers to a universal questionnaire. (Loeb, 2:40-42.) According to Loeb, "consumer magazine publishers pursue consumers and subscriptions in very different ways from trade publication publishers. For instance, in the consumer environment, 60% of all new subscriptions are acquired by third-party service providers known as agents." (*Id.*, 2:9-16.) Loeb suggests that "[a]gents enjoy a superior economic model because they acquire subscriptions for dozens of magazines simultaneously. Thus, agents can pass on acquisition costs to multiple publishers." (*Id.*) According to Loeb, "[t]he agency model has no parallel in the trade publication universe." (*Id.*, 2:16-18.)

B. Response to rejections under 35 U.S.C. § 103(a) over a combination of Ryan and Giacomozzi

The Examiner rejected claims 1-7, 11, 14, 16-18, 20-23, 26-27, 29-32, 34-40, 43-45, 49, 51-54, 57-59, and 61-67 under 35 U.S.C. § 103(a) over a combination of Ryan and Giacomozzi. Applicant respectfully traverses this rejection.

1. Ryan and Giacomozzi, individually and in combination, do not disclose or suggest "wherein the promotional material is specifically targeted to a group of people associated with the paper purchaser, the group comprising those people likely to purchase the goods or services of the third-party advertiser"

The Examiner suggests that Ryan discloses "wherein the promotional material is specifically targeted to a group of people associated with the paper purchaser, the group comprising those people likely to purchase the goods or services of the third-party advertiser," as recited by claim 1. (Office Action, May 22, 2008, pages 11-12.) In particular, the Examiner states:

Ryan teaches targeting ads to commercial users (see col 9, lines 50-55), targeting ads to a cluster of recipients (i.e. group), were said clustering is based

upon geographic location (see col 13, lines 32-34) and furthermore, Ryan teaches that advertisers target an audience (i.e. group of people) (see col 3, lines 1-2).

(*Id.*, emphasis added.) Applicant respectfully disagrees with this characterization of Ryan. In the first section of Ryan cited to by the Examiner, the "commercial user" is a user of the production mail system, and not a recipient of a mailpiece, as the Examiner suggests. (Ryan, 8:26-31, 9:1-10:27: The user profile 804 includes information that has been established with a postage meter module, such information includes classification data 804a [that] includes an indication of whether the user is a commercial user, a residential user, or a dual mode user.)

In the second section of Ryan cited to by the Examiner, Ryan describes presorting multiple letters of outgoing mail to take advantage of a postal discount. (*Id.*, 13:32-34.) It is not correct to say that a cluster of Ryan's letters is the same as one of applicant's paper products (be it a roll of paper or a stack of unbound paper sheets) for at least the reason that a cluster of Ryan's letters is not surrounded by an enclosure having promotional material. The second section of Ryan cited by the Examiner and other sections clearly show that each individual piece of mail is addressed to a single recipient, and the advertisements placed on each piece of mail target only that single recipient. (*Id.*, 5:38-40, 13:32-34.) Indeed, there is nothing in Ryan that teaches or suggests that a single letter is "specifically targeted to a group of people...likely to purchase the goods or services of the third-party advertiser."

In the third section of Ryan cited to by the Examiner, Ryan describes the disadvantages of a non-targeted advertising arrangement. (*Id.*, 3:1-2.) For example, Ryan explains that "advertisements (e.g., sports related or hair loss), intended primarily for males may not be relevant if the recipient of the mailpiece from the postage meter user was a female." (*Id.*, 3:1-4.) The third section, therefore, further supports Ryan's disclosure of advertisements directed to individual recipients, but teaches away from targeting groups. In contrast to Ryan, applicant's technology places advertisements

directed to a group of recipients on each enclosure. For example, claim 1 includes "plac[ing] promotional material on an enclosure of a paper product, wherein the promotional material is specifically targeted to a group of people associated with the paper purchaser, the group comprising those people likely to purchase the goods or services of the third-party advertiser." There is nothing in Ryan that teaches or suggests that the advertisements on individual letters are each directed to a "group of people associated with the paper purchaser," as recited by the pending claims.

Moreover, applicant further submits that Giacomozzi does not target advertisements at all, but rather assumes that anyone in the general public might view the handkerchief wrappers. For example, Giacomozzi suggests that its handkerchief wrapper "represents a possible publicity vehicle with large diffusion" because the wrapper "is pulled out and shown, by the user, to the public each time a handkerchief is taken." (Giacomozzi, page 1.) Thus, applicant respectfully submits that the pending claims are patentable over the combination of Ryan and Giacomozzi.

2. Ryan and Giacomozzi, individually and in combination, do not disclose or suggest that "the group of people are likely to view the promotional material on the enclosure for an extended period of time"

As amended, claims 1, 11, 18, 22, 61 recite that "the group of people are likely to view the promotional material on the enclosure for an extended period of time."¹ As was made clear in applicant's Response mailed on February 28, 2008, applicant's recited enclosure differs significantly from the envelopes and handkerchief wrappers of Ryan and Giacomozzi. The differences are evident, for example, with respect to: 1) the delivery means for the product, 2) what happens to the product before use, and 3) who is exposed to the product. An envelope, as in Ryan, typically arrives at a recipient's address, is read and opened by the recipient, and then is quickly discarded. A handkerchief wrapper, as in Giacomozzi, typically sits on a store shelf where it is

¹ Support for this amendment can be found, for example, in paragraphs [0038] and [0045] of applicant's published specification.

exposed to an unknown group of people, is purchased, and then is stored in a purse or a pocket except for brief periods when a handkerchief is removed, at which time it may again be exposed to an unknown group of people. By contrast, the enclosures of the pending claims, which enclose rolls of paper or unbound, stacked paper sheets (e.g., on reams of paper), typically sit stacked in an oft-frequented office area (e.g., a copy room) for weeks or months at a time. The people exposed to the enclosures are typically an identifiable audience, e.g., the office employees. Thus, it is possible to place promotional material on such an enclosure that is targeted to a known group of people and that will be exposed to the people for an extended period of time. Neither Ryan nor Giacomozzi teach or suggest this type of advertising. Thus, for at least this additional reason, claims 1-25 61-64, and 66-67 are patentable over the combination of Ryan and Giacomozzi.

3. Ryan and Giacomozzi, individually and in combination, do not disclose or suggest that "the paper product including a roll of paper or a plurality of unbound, stacked paper sheets"

The Examiner suggests that Figure 1 and column 6, lines 37-42 of Ryan disclose "[a] paper product including a plurality of unbound, stacked paper sheets." (Office Action, May 22, 2008, pages 3-4, 12, emphasis added.) Applicants respectfully disagree with this characterization of Ryan. Ryan makes clear that its system "assembles together successive pages all pertaining to a particular document, respectively." (Ryan, 6:37-42, emphasis added.)² Thus, Ryan does not disclose a paper product including a plurality of unbound, stacked paper sheets, as recited.

4. Ryan and Giacomozzi teach away from their combination

Assuming for the sake of argument that the combination of Ryan and Giacomozzi discloses all of the claimed features, applicant respectfully submits that the references

² Moreover, Ryan explains that such "documents may originate from a stack of cut sheets...[and that] it is the function of the inserter system to accept the documents and produce the individual mailpieces that correspond to each document." (*Id.*, 1:48-51.)

cannot properly be combined because Ryan and Giacomozzi teach away from their combination. Ryan teaches away from placing promotional material on Giacomozzi's wrappers. Specifically, Ryan teaches away from placing promotional material on items when "the third party advertiser cannot exercise any control over who receives the message." (Ryan, 2:65-66.) Thus, Ryan teaches away from placing promotional material on Giacomozzi's wrappers because the advertiser cannot exercise any control over who receives the message. Rather, the message is received by random individuals who either purchase Giacomozzi's handkerchief packages or notice the promotional message on one of Giacomozzi's handkerchief packages. This is precisely the type of advertising Ryan's invention is designed to avoid. As the Examiner correctly noted previously, Ryan's invention is directed at "resolv[ing] this problem by giving advertisers control over targeting their messages." (Office Action, August 16, 2006, page 10.) Accordingly, the Examiner's suggested use of Ryan's system to print promotional material onto Giacomozzi's wrappers contravenes one purpose of Ryan's invention—overcoming the disadvantage of conventional advertising campaigns in which the third party advertiser cannot exercise control over who receives the message. (Ryan, 2:65-66.)

Giacomozzi also teaches away from combining his disclosed features with those of Ryan. Giacomozzi's system is directed to displaying promotional messages to the public at large, not messages targeted to a specific recipient (including the purchaser of the paper handkerchiefs). For example, Giacomozzi states, "[t]he wrapping containing paper handkerchiefs, in fact, is pulled out and shown, by the user, to the public each time a handkerchief is taken from the same, and this represents a possible publicity vehicle with large diffusion." (Giacomozzi, page 1.) Ryan targets promotional messages to the single recipient of a message, in direct conflict with the large diffusion for which Giacomozzi's system is designed. Therefore, one skilled in the art would not be motivated to combine Ryan's disclosed features with those of Giacomozzi, or Giacomozzi's disclosed features with those of Ryan. For at least the foregoing reasons,

applicant respectfully submits that the pending claims are patentable over Ryan and Giacomozzi.

For similar reasons to those discussed above with regard to claim 1, applicant respectfully submits that independent claims 11, 18, 22, 26, 31, 34, 49, 52, 57, and 61 are also patentable over Ryan and Giacomozzi. For example, each of these claims recites promotional material or an advertisement "specifically targeted to a group of people associated with the paper purchaser, the group comprising those people likely to purchase the goods or services of the third-party advertiser." Accordingly, applicant respectfully requests that the Examiner reconsider and withdraw the rejection of these claims and their dependents under 35 U.S.C. § 103(a) over combinations of Ryan, Giacomozzi, Itkonen, Crossman, and Loeb.

5. The Examiner has failed to establish a *prima facie* rejection of claims 17, 37-38, 65, and 67

Obviousness requires the Examiner to identify where every element of the claimed invention is disclosed or suggested by the applied references. The Manual of Patent Examining Procedure provides that "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art." (MPEP § 2143.03, emphasis added). As discussed in detail below, applicant respectfully submits that the Examiner has not done so with respect to claims 37-38, 65, and 67.

In rejecting claims 37-38, the Examiner states:

As per claims 2, 14, 16, 18, 20-23, 26, 27, 31, 32, 34-39, 49, 52-54, 58-59, and 62-63, Ryan teaches: a remuneration tracker configured to track remuneration paid by the third-party advertiser for the promotional material and tracking receipt of remuneration from the paper purchaser for the paper product (see Ryan column 10, lines 7-17).

(Office Action, May 22, 2008, page 6.) However, claim 37 recites "the method of claim 34, further comprising disposing the promotional material on the enclosure before disposing the paper product within the enclosure" and claim 38 recites "the method of

claim 34, further comprising disposing the promotional material on the enclosure after disposing the paper product within the enclosure." Thus, because the Examiner did not indicate how these features are disclosed or suggested by the references, applicant respectfully submits that the Examiner has failed to establish a *prima facie* case of obviousness of claims 37 and 38. Accordingly, applicant respectfully requests that the Examiner reconsider and withdraw the rejection of these claims under 35 U.S.C. § 103(a) over the combination of Ryan and Giacomozzi.

In rejecting claim 65, the Examiner states:

As per claim 65, Ryan teaches: instructing another entity to dispose the promotional material on the enclosure (see column 10, lines 50-64).

(Office Action, May 22, 2008, page 8.) Applicant respectfully disagrees with this characterization of Ryan. In the section of Ryan cited by the Examiner, Ryan describes that a third-party advertiser may indicate whether or not other third-party advertisers are allowed to occupy ad space on an envelope that includes the advertiser's message. (Ryan, 10:50-64.) Ryan explains that when multiple messages are printed on an envelope, the effectiveness of each advertiser's message is diluted. (*Id.*) However, nowhere does Ryan disclose or suggest that an advertiser's profile (containing the multi-ad restriction data) is used by Ryan's processing system to instruct another entity to dispose the advertiser's message on an envelope. Thus, because the Examiner did not indicate how this feature is disclosed or suggested by the references, applicant respectfully submits that the Examiner has failed to establish a *prima facie* case of obviousness of claims 65. Accordingly, applicant respectfully requests that the Examiner reconsider and withdraw the rejection of this claim under 35 U.S.C. § 103(a) over a combination of Ryan and Giacomozzi.

In rejecting claim 67, the Examiner states:

As per claim 67, Ryan does not expressly teach wherein the paper purchaser manufacturer is an office and the group of people are employees that work in the

office. However, Official Notice is taken that it is old and well known in the business art that offices' employees order paper products. Therefore, it would have been obvious...to know that offices employees would include advertisements into wrappers of order paper products, as taught by Ryan in view that said advertisers would subsidize the cost of said paper products.

(Office Action, May 22, 2008, pages 8-9, emphasis added.) Applicant is puzzled by the Examiner's reasoning. The Examiner takes official notice that "it was well known that offices' employees order paper products." (Office Action, May 22, 2008, page 8.) However, if an office employee ordered mail pieces using Ryan's system, as suggested by the Examiner, the advertising placed on the envelopes would not be targeted to the office employee, but rather to the recipient of the mailer. (Ryan, 5:31-39.) Thus, even using the Examiner's reasoning, Ryan fails to disclose or suggest promotional material specifically targeted to employees associated with an office, as recited by claim 67.

Moreover, applicant respectfully submits that the Examiner's suggested motivation appears to be gleaned directly from applicant's specification, which provides at paragraph [0047], for example, that "the end user may pay less for paper enclosed in a wrapper or carton bearing promotional materials than he would pay for conventionally enclosed paper." For at least these reasons, applicant respectfully submits that claim 67 is patentable over the cited references. Accordingly, applicant respectfully requests that the Examiner reconsider and withdraw the rejection of this claim under 35 U.S.C. § 103(a) over the combination of Ryan and Giacomozzi.

C. Response to rejections under 35 U.S.C. § 103(a) over a combination of Ryan, Giacomozzi, and Itkonen

The Examiner rejected claims 8, 9, 24, 28, 42, and 56 under 35 U.S.C. § 103(a) over a combination of Ryan, Giacomozzi, and Itkonen. Applicant respectfully traverses this rejection.

1. The Examiner has failed to establish a *prima facie* rejection of claims 24, 28, 42, and 56

In rejecting claims 24, 28, 42, and 56, the Examiner states:

As per claims 8, 24, 28, 42, and 56, Ryan fails to teach: wherein the promotions tracker is configured to receive an order for an advertisement placed on a wrapper configured to enclose a roll of paper. However, Itkonen teaches a method for wrapping a roll of paper, where said wrapper is often printed with advertisement (see column 1, lines 64-67).

(Office Action, May 22, 2008, page 9, emphasis added.) However, each of these claims recites a ream of paper or a ream wrapper, which is different from a roll of paper.³ (See, e.g., applicant's specification, ¶ [0017].) Thus, because the Examiner did not indicate how a ream of paper or a ream wrapper is disclosed or suggested by the references, applicant respectfully submits that the Examiner has failed to establish a *prima facie* case of obviousness of claims 24, 28, 42, and 56.⁴ Accordingly, applicant respectfully requests that the Examiner reconsider and withdraw the rejection of these claims under 35 U.S.C. § 103(a) over a combination of Ryan, Giacomozzi, and Itkonen.

2. Ryan, Giacomozzi, and Itkonen teach away from their combination

Applicant respectfully submits that Ryan, Giacomozzi, and Itkonen teach away from their combination. The Examiner suggests the following as the reason to combine Ryan and Itkonen:

³ Claim 24 recites "wherein the order tracker is configured to track an order for an advertisement placed on an external surface of a wrapper configured to enclose a ream of paper." (Emphasis added.) Claim 28 recites "receiving an indication of an order for an advertisement disposed on an external surface of a ream wrapper." (Emphasis added.) Claim 42 recites "providing instructions for disposing promotional material on a ream wrap configured to enclose a ream of paper." (Emphasis added.) Claim 56 recites "wherein the plurality of stacked unbound paper sheets includes a ream of paper." (Emphasis added.)

⁴ For similar reasons, applicant respectfully submits that the Examiner has failed to establish a *prima facie* rejection of claims 32 and 49, which also recite a ream of paper. In addition, applicant further submits that the Examiner has also failed to establish a *prima facie* rejection of claim 44, which recites "a skid wrap configured to enclose a stack of unbound paper on a skid," and claims 45 and 61, which recite "providing instructions for disposing promotional material on a carton configured to contain the paper product."

[I]t would have been obvious...to know that the same method use by Ryan to print advertisements in the enclosure of unbound, stacked paper sheets (Ryan figure 1, item 17) would be used to print advertisements in Itkonen's roll wrapper of a roll of paper sheets in view that said wrapper would include promotions that would subsidize the cost of producing and wrapping said paper roll, as taught by Ryan.

(Office Action, May 22, 2008, page 9, emphasis added.) Applicant respectfully disagrees and submits that Itkonen teaches away from Ryan. For example, Itkonen explains that "[r]oll wrappers are often printed with factory logos, thus acting as factory 'visiting cards'." (Itkonen, 1:64-67, emphasis added.) Itkonen further explains that removing the crease in roll wrappers is important because, "[a] creased roll wrapper looks ugly and thereby acts as bad advertising for the product and factory image." (*Id.*, emphasis added.) In other words, Itkonen is directed to "mill branding" (see, e.g., applicant's specification, ¶ [0018]), and thus one would not be motivated to combine Ryan with Itkonen. Moreover, Itkonen's teaches away from Giacomozzi because, while Itkonen is directed to mill branding, Giacomozzi is directed to wrappers having advertisements that are not linked to the wrapped product (i.e., handkerchiefs). For at least this reason, applicants respectfully submit that claims 8, 9, 24, 28, 42, and 56 are patentable over the combination of Ryan, Giacomozzi, and Itkonen. Accordingly, applicant respectfully requests that the Examiner reconsider and withdraw the rejection of these claims under 35 U.S.C. § 103(a) over a combination of Ryan, Giacomozzi, and Itkonen.

D. Response to rejections under 35 U.S.C. § 103(a) over a combination of Ryan, Giacomozzi, and Crossman

The Examiner rejected claims 10, 25, 33, 41, 55, 60, and 64 under 35 U.S.C. § 103(a) over a combination of Ryan, Giacomozzi, and Crossman. Applicant respectfully traverses this rejection.

1. There is no reason to combine Ryan Giacomozzi and Crossman

Applicant respectfully submits that the Examiner has not identified a sufficient reason for combining Ryan, Giacomozzi, and Crossman. To present a *prima facie* case of obviousness, the Examiner must show that "there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue." (*KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, at 1740-41 (2007).) The Examiner's analysis "should be made explicit." (*Id.*) "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." (*Id.*, citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006).)

The Examiner suggests the following as the reason to combine Ryan, Giacomozzi, and Crossman:

It would have been obvious to...know that Ryan would include third party advertisers coupons into a package wrappers, as taught by Crossman in order to offset the cost of producing said products by billing advertisers for said including, as taught by Ryan.

(Office Action, May 22, 2008, page 10, emphasis added.) Applicant respectfully disagrees with this suggestion, and submits that the Examiner has not provided a sufficient reason to combine Ryan and Crossman. Ryan already includes third-party advertisements on envelopes as a way of offsetting the cost of producing mailpieces by billing advertisers (see, e.g., Ryan, 2:42-45.) So Ryan already has the advantage the absence of which the Examiner suggests would motivate one to combine Ryan with Crossman. Thus, one would have no reason to combine Ryan and Crossman to achieve this advantage.

2. Ryan, Giacomozzi, and Crossman teach away from their combination

Moreover, applicant respectfully submits that Ryan, Giacomozzi, and Crossman teach away from their combination. As discussed above, Ryan is directed to printing

third-party advertisements on envelopes. (Ryan, 11:43-46.) In contrast, Crossman is directed to packaging having a detachable coupon compartment. (Crossman, 1:5-9.) For example, Crossman makes clear that "[w]hen the coupon compartment is detached, the packaging is still functional." Moreover, Crossman discredits techniques, like Ryan's, which print the promotional message directly onto the packaging, because, according to Crossman, "[c]oupons printed directly onto packaging...are not easily removed and if they are removed, the packaging is damaged." (*Id.*, 1:10-22) Thus, applicant respectfully submits that it is improper to combine Ryan and Crossman because they teach away from their combination. For at least this reason, applicant respectfully submits that claims 10, 25, 33, 41, 55, 60, and 64 are patentable over Ryan, Giacomozzi, and Crossman. Accordingly, applicant respectfully requests that the Examiner reconsider and withdraw the rejection of these claims under 35 U.S.C. § 103(a) over a combination of Ryan, Giacomozzi, and Crossman.

E. Response to rejections under 35 U.S.C. § 103(a) over a combination of Ryan, Giacomozzi, and Loeb

1. The Examiner has failed to establish a *prima facie* rejection of claims 19 and 50

In rejecting claims 19 and 50, the Examiner states:

As per claims 12, 13, 15, 19, 46, 47, and 50, Ryan fails to teach: wherein receiving a paper product order includes receiving the order from an intermediate party, with the intermediate party receiving the order from the paper purchaser or third-party advertiser and tracking receipt of remuneration from the third-party advertiser to an intermediate party for the promotional material.

(Office Action, May 22, 2008, page 11.) Claims 19 and 50 recite "instruct[ing] an intermediate party to place the advertisement on the wrapper." Because the Examiner did not indicate how this feature is disclosed or suggested by the references, applicant respectfully submits that the Examiner has failed to establish a *prima facie* case of obviousness of claims 19 and 50. Accordingly, applicant respectfully requests that the

Examiner reconsider and withdraw the rejection of these claims under 35 U.S.C. § 103(a) over the combination of Ryan, Giacomozzi, and Loeb.

2. One skilled in the art would have no reasonable expectation of success combining Ryan, Giacomozzi, and Loeb

The Examiner suggests the following as the reason to combine Ryan, Giacomozzi, and Loeb:

It would have been obvious ...to know that Ryan would use intermediary parties (i.e., agents) that would bring more customer to order paper products. The intermediary party would be more than willing to serve as an intermediary in the interaction between the paper purchasers and advertisers because said intermediary party would receive remuneration from said interaction.

(Office Action, May 22, 2008, page 11, emphasis added.) However, applicant respectfully submits that one skilled in the art would have no reasonable expectation of success combining Ryan, Giacomozzi, and Loeb, because a technique for doing so would entail complexities that would require detailed explanation for one of ordinary skill in the art to implement, which is not present in either Ryan, Giacomozzi, or Loeb. For example, Loeb only comments on the use of agents in the context of selling magazine subscriptions to consumers (Loeb, 2:9-18)⁵, while Ryan explains that every user and advertiser of Ryan's production mail system establishes a profile with the system, and it is through these profiles that users and advertisers submit orders. (Ryan, 8:26-9:45, 11:23-30.) Thus, it is unclear how one of ordinary skill in the art would integrate Loeb's agents with Ryan's production mail system to produce the claimed invention. For at least this reason, applicant respectfully submits that claims 12, 13, 15, 19, 46, 47, and 50 are patentable over Ryan, Giacomozzi, and Loeb. Accordingly, applicant respectfully requests that the Examiner reconsider and withdraw the rejection of these claims under 35 U.S.C. § 103(a) over a combination of Ryan, Giacomozzi, and Loeb.

⁵ Moreover, Loeb makes clear that "the superior economic model" enjoyed by agents selling consumer magazine subscriptions has no parallel in trade publications. Therefore, it is unclear (and Loeb does not explain) how such a model would be employed outside of selling consumer magazine subscriptions.

V. Conclusion

In view of the above amendment and remarks, applicants believe the pending application is in condition for allowance. If the Examiner has any questions or believes a telephone conference would expedite examination of this application, the Examiner is encouraged to call the undersigned directly at (206) 359-8077.

Please charge any deficiencies or credit any overpayments to our Deposit Account No. 50-0665, under Order No. 33582.8001.US1 from which the undersigned is authorized to draw.

Dated: 22-Sept. 2008

Respectfully submitted,

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